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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/673,305 | 03/19/2001 | Roger Read | 047763-5017 | 5146 |

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EXAMINER

ROBINSON, BINTA M

ART UNIT PAPER NUMBER

1625

DATE MAILED: 07/03/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/673,305

Applicant(s)

READ ET AL.

Examiner

Binta M. Robinson

Art Unit

1625

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 22-49 is/are pending in the application.
- 4a) Of the above claim(s) 18-20, 24, 30-34, 36, 41 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, 15, 17 and 27-29 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 10-14, 16, 22, 23, 25, 26, 35, 37-40, 42-45 and 47-49 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: ____. |

Detailed Action

The examiner notes the applicant's election of group I at paper no. 12. The unelected claims 18-21, 24, 30-34, 36, 41, 46 are withdrawn from consideration.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 3, 4, 5, 6, 9, 15, 17, 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In claim 1, line 9, page 25, the term "=O" is indefinite. Is this group a carbonyl group?

B. Claim 2 recites the limitation "formula (Ia)" in line 1, on page 25. There is insufficient antecedent basis for this limitation in the claim.

C. Claim 3 recites the limitation "formula (II)" in line 1, page 26. There is insufficient antecedent basis for this limitation in the claim.

D. Claim 4 recites the limitation "formula (III)" in line 1, page 27. There is insufficient antecedent basis for this limitation in the claim.

E. Claim 5 recites the limitation "formula (IV) or (V)" in line 1, page 27. There is insufficient antecedent basis for this limitation in the claim.

F. In claim 6, line 1, page 28, and in claims 9, 17, 27-29, the phrase "fimbrolide derivative" is indefinite because it is not a statutory class of invention. The phrase "fimbrolide composition" is suggested.

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G. In claim 6, line 3, page 28, and in claim 9, the term "compounds" is indefinite. It is unclear as to whether or not the applicant is forming a composition or a compound. The phrase "a compound" is suggested.

H. In claim 15, line 1, page 31, the phrase "A method for forming a fimbrolide analogue derived from a compound of formula (III)" is indefinite. An analogue is not a statutory class of invention. The phrase "a compound" or a "composition" is suggested. Secondly, it is not clear what compound is being claimed. What derivative of compound of formula III is being claimed?

2. Claims 7-8, 10-14, 16, 22, 23, 25-26, 35, 37-40, 42-45, 47-49 are objected to because they are based on a rejected claim.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.



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